REMARKS

This responds to the Office Action mailed on June 16, 2005, and the references cited therewith. Claims 1-45 remain and thus are pending in this application. Applicant appreciates the Examiner's indicated allowable subject matter.

§*103 Rejection of the Claims*

Claims 1-13, 16-28 and 31-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Narashimhalu et al. (U.S. 5,499,298).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

> In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

> reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the reason that Narashimhalu fails teach or suggest elements of the independent claims, as contended in the Office Action (OA).

Narashimhalu discusses controlling the dissemination of digital information. The digital information is structured logically to incorporate usage history and allowable access window before it is encrypted in a header portion and a body portion (see Fig. 2). The end user accesses the digital information with a tamper-proof controlled information access device by decrypting the digital information. As illustrated in Figure 2 and discussed at column 5, lines 35-52, the logical structure of encoded information is a sealed COIN (controlled information) which includes an encrypted header 35 and an encrypted body 40 (col. 6, ln. 43-45).

The OA indicates transmitting a license from a server to a secure device for storage, the license containing a product key of a watercrypted content and a client identifier as being disclosed by Figure 2, column 5, lines 35-50, "the header of the COIN structure contains a signature field equivalent to a client identifier." (OA, pg. 2) Applicant respectfully disagrees with the characterization of the prior art. In Narashimhalu, the signature field (or any other header field) of the COIN's header referred to in the OA is neither a client identifier nor a product key, as recited in claim 1. The medium signature 36 of Narashimhalu is defined as, "any scheme which allows a distribution medium, such as a floppy disk, to have a unique identification. Preferably, this signature depends upon the characteristics or nonuniformities of the distribution medium." (col. 5, ln. 49-52) Thus, Narashimhalu merely discloses a signature field that identifies a distribution medium (e.g., CDROM, floppy disk, etc.), which is neither a client identifier nor a product key. Therefore, Narashimhalu in view of what was known in the art at the time of invention does not render obvious, transmitting a license from a server to a secure

device for storage, the license containing a product key of a watercrypted content and a client identifier, as recited in claim 1.

Additionally, Narashimhalu does not disclose transmitting via an electronic network an entitlement control message containing a plurality of content keys associated with said watercrypted content to said secure device, together with a request to provide a session content key from said plurality of content keys, said session content key to be used to decrypt said watercrypted content. Narashimhalu includes the access rights and the decryption keys for decoding the sealed COIN in a header portion of a distribution medium (e.g., CDROM, floppy disk, etc.). As such, Narashimhalu does not disclose transmitting a license from a server to a secure device or transmitting via an electronic network an entitlement control message containing a plurality of content keys associated with said watercrypted content to said secure device, together with a request to provide a session content key from said plurality of content keys, as recited in claim 1.

For at least the above reasons, claim 1 is not obvious with respect to Narashimhalu in view of what was known in the art at the time of the Applicant's invention.

The arguments provided above with respect to claim 1 also apply to independent claims 11, 16, 26, 31, 32 and 33. Because dependent claims include all the limitations of the claims from which they depend, the dependent claims of claims 1, 11, 16, 26, 31, 32 and 33 are also patentable over Narashimhalu.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4045 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ROBERT W. FRANSDONK

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4045

Date 10/17/2005

By _____
Larry J. Johnson
Reg. No. 56,861

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17 day of October, 2005.

Dawn R. Shaw — Dawn R. Shaw

Name — Signature